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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,570	10/03/2000	Thomas J. Reid	55409USA3A.002	5623

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3M INNOVATIVE PROPERTIES COMPANY  
PO BOX 33427  
ST. PAUL, MN 55133-3427

EXAMINER

YAO, SAMCHUAN CUA

ART UNIT PAPER NUMBER

1733

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



# Office Action Summary

Application No.

09/678,570

Applicant(s)

REID ET AL.

Examiner

Sam Chuan C. Yao

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 13
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:



### DETAILED ACTION

NOTE: the amendment that was submitted via fax on 09-16-03 was not entered.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 8, and 13-14 rejected under 35 U.S.C. 102(b) as being anticipated by Hoogstoel (US 3,607,540) for reasons of record set forth in Paper No. 4 numbered paragraph 4.

3. Claims 1 and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Australia 265,749 for reasons of record set forth in Paper No. 4 numbered paragraph 5.

4. Claims 1, 5-10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Moriya et al (US 5,256,472).

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-7, 9-10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoogestoel (US 3,607,540) as applied to claim 1 above for reasons



Art Unit: 1733

of record set forth in Paper No. 4 numbered paragraph 7 and for reasons set forth hereinafter.

Since one in the art would have readily understood and appreciated that, the process taught by Hoogestoel can be applied to any wood substrates such as a teak, it would have been obvious in the art to apply the process taught by Hoogestoel on a wood teak. Moreover, since it is conventional in the art to form a backing film from a flexible aliphatic polyurethane, and since an acrylic PSA is notoriously well known in the art, forming an acrylic PSA coated flexible aliphatic polyurethane backing would have been obvious in the art.

Hoogestoel teaches using a glycerin or ethylene glycol a barrier layer to a PSA and applying a wetting agent onto the barrier layer. However, Hoogestoel does not teach applying such a barrier layer onto a wood substrate and then applying a wetting agent onto the barrier layer. However, it would have been obvious in the art to apply a glycerin or ethylene glycol barrier layer onto a wood substrate instead of applying it on a surface a PSA and then apply a wetting agent onto the barrier layer, as such is taken to be well within the purview of choice in the art.

One in the art would have readily understood that, whether a barrier layer is applied onto a PSA or a wood substrate, the barrier layer would effectively perform the same function of allowing a PSA coated backing film to shift without tearing or wrinkling the backing film.



Art Unit: 1733

7. Claim 11-12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoogestoel (US 3,607,540) as applied to claim 1 above, and further in view of Australia 265,749.

With respect to claim 11-12, since Australia, drawn to a process of providing a film covering onto a substrate such as a wood, the process being a type most similar to Hoogestoel, teaches applying a solvent based adhesive onto one of the film covering surface and substrate surface, or alternatively, applying different types of solvent based adhesive on both surfaces of the film and substrate, and further teaches using various types of adhesive such as a polyurethane adhesive (page 2 full paragraph 1 to page 3 full paragraph 2); these claims would have been obvious in the art.

With respect to claim 17, the discussion presented herein is alternative to numbered paragraph 6 above. Note further that, the discussion in numbered paragraph 5 above regarding teak, acrylic PSA and aliphatic polyurethane film is incorporated herein. As for the limitation of applying a polymer liquid coating on a wood substrate and then applying a wetting agent, since Australia teaches applying a solvent based adhesive onto one of the film covering surface and substrate surface or alternatively applying different types of solvent based adhesive on both surfaces of the film and substrate; and since it is old in the art to apply a wetting agent onto an adhesive before performing a laminating step, claim 17 would have been obvious in the art.



Art Unit: 1733

8. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoogstoel (US 3,607,540) as applied to claim 1 above for reasons of record set forth in Paper No. 4 numbered paragraph 8.

9. Claims 2, 4 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moriya et al (US 5,256,472) as applied to claim 1 above as applied to numbered paragraph 4 above for essentially the same reasons set forth above.

***Response to Arguments***

10. Applicant's arguments filed on 08-14-03 have been fully considered but they are not persuasive.

In response to Counsel's argument on page 4 regarding Applicant's claimed method of finishing a wood substrate and the Hoogstoel patent, it is respectfully submitted that, Counsel's argument is NOT commensurate with the scope of the recited claims. The claims as presently recited do not require using a transparent film. Even for the sake of argument, such is required, it would have been obvious in the art to apply the technique of Hoogstoel in a process to a known process, where a PSA coated transparent protective film is applied onto a wood substrate so that the protective film can be applied on a wood substrate without a problem of wrinkling. As for the intended use limitation of "*for exterior exposure of the wood*", the resultant wood articles taught by Hoogstoel is capable of being exposed to exterior environment.



Art Unit: 1733

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Chuan C. Yao whose telephone number is (703) 308-4788. The examiner can normally be reached on Monday-Friday with second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W Ball can be reached on (703) 308-2058. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



Sam Chuan C. Yao  
Primary Examiner  
Art Unit 1733

Scy  
09-21-03



<b>Interview Summary</b>	Appli ation No.	Applicant(s)	
	09/678,570	REID ET AL.	
	Examiner	Art Unit	
	Sam Chuan C. Yao	1733	

All participants (applicant, applicant's representative, PTO personnel):

(1) Sam Chuan C. Yao. (3)\_\_\_\_\_.

(2) Scott Pribnow. (4)\_\_\_\_\_.

Date of Interview: 16 September 2003.

Type: a) ☒ Telephonic b) ☐ Video Conference  
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☐ No.  
If Yes, brief description: \_\_\_\_\_.

Claim(s) discussed: all.

Identification of prior art discussed: N/A.

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☒ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Examiner initiated the call. Proposed canceling claim 1 and allowing independent claim 17. Counsel agreed. On the same day, Examiner left a telephone message to Counsel's voice mail to inform him that, after further reading and analyzing the art of record, the proposal to allow claim 17 is being withdrawn. Proposed adding claims 12 and 15 to claim 17 to make claim 17 allowable. No response from Counsel was received.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

\_\_\_\_\_  
Examiner's signature, if required



## Summary of Record of Interview Requirements

### Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

### Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

#### Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

#### 37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,  
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

### Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.